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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,744	09/04/2001	Shigeyoshi Yoshida	0694-149	2676

7590 04/26/2005

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EXAMINER	
KOSLOW, CAROL M	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/914,744	YOSHIDA ET AL.	
	Examiner	Art Unit	
	C. Melissa Koslow	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6-9 and 12-21* is/are pending in the application.

4a) Of the above claim(s) *13 and 15-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6-9,12,14 and 18-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/28/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This action is in response to applicants' amendment of 28 February 2005. The amendments to the claims have overcome the 35 USC 112 rejections and the rejection over JP 09-181476. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

JP 05-047552 and JP 07-086035, cited on in the information disclosure statement of 28 February 2005, have lines drawn through them since they were cited in the information disclosure statement of 7 October 2004 and which have already been considered.

JP 10-025530 and JP 10-117086, cited on in the information disclosure statement of 28 February 2005, have been considered with respect the provided English abstracts.

This application contains claims 13 and 15-17 drawn to an invention nonelected with traverse in the paper dated 4 April 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claimed thin film thickness and the claimed brw range of 148-200% are not found in the specification.

Claims 1-4, 6-9, 12, 14 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

These claims are new matter. Amended claim 3 and new claim 20 teaches the composition of claim 3 has a complex permeability frequency response of a relatively broad range and amended claim 6 and new claim 21 teach the composition of claim 6 has a complex permeability frequency response of a relatively narrow range. Original claims 2 and 3 taught the composition of claim 3 has a complex permeability frequency response of a relatively narrow range and original claims 5 and 6 taught the composition of claim 6 has a complex permeability frequency response of a relatively broad range.

The change from "a thin film magnetic substance" to "a thin film magnetic loss material" is new matter. Nowhere in the specification is there a teaching of a magnetic loss material. It is noted that this phrase has no meaningful definition in the art since all magnetic materials exhibit some loss and thus is given no weight.

Claims 3, 4, 6-9, 14 and 18-21 are indefinite since the rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite since the preambles of these claims do not match the preamble of claim 1, from which they all ultimately depend. The rejected claims recite the limitation "the magnetic substance". There is insufficient antecedent basis for this limitation in these claims or in claim 1, from which they all ultimately depend.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4, 6-9, 12, 14 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Han et al.

This article teaches producing a thin film, having a thickness of 1 micron, of Fe distributed as granular grains in an alumina matrix by sputtering. This composition would have the claimed formula Fe-Al-O. Figure 6 shows that this material has an electric resistance in the range of about 100 μΩ•cm up to about 1000 μΩ•cm and a saturation magnetization of 10 to 15 kG. The ratio of the taught saturation magnetization to the bulk saturation magnetization of Fe (22 kG) is 45.5-68.2%. This range falls within the claimed ranges. The article does not teach the brw of the taught composite and the frequency at which the maximum μ" occurs. The taught composite is produced by the same process as that claimed and therefore must have a brw and a frequency at which the maximum μ"occurs that falls with the claimed ranges, absent any showing to the contrary. When the prior art and appellant both describe processes which are indistinguishable, then the products may also be assumed to be inherently indistinguishable. *In re Myers* 159 USPQ 339 (CCPA 1968); *In re Prindle* 132 USPQ 282 (CCPA 1962). Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 1950). The reference teaches the claimed material.

Applicants' state the rejection stated certain values appear to overlap those of the claimed device. This is incorrect. The rejection stated the taught electrical resistance and calculated ratio of saturation magnetization to the bulk saturation magnetization of Fe falls within the claimed ranges. The rejection also stated that one of ordinary skill in the art would expect the brw and the frequency at which the maximum μ" occurs to fall within the claimed ranges, absent any showing to the contrary. Applicants have not shown that the taught composition does not have any of the above properties that do not fall within the claimed ranges nor have they provided any

arguments explain why one of ordinary skill in the art would not expect the brw and the frequency at which the maximum μ" occurs to fall within the claimed ranges. Applicants do not address the brw and the frequency at which the maximum μ" occurs in their arguments.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the argued exact values of μ") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the taught magnetic thin film has a different use than that intended for the claimed thin film, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, both the claimed and taught materials have the same structure and composition and there has been no showing that the taught material cannot be used as a magnetic loss material. The rejection is maintained.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
April 22, 2005

C. Melissa Koslow
Primary Examiner
Tech. Center 1700